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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,365	11/26/2001	Patrick R. Charmley	CECH118109	7286

7590 08/05/2004  
 DAVIS WRIGHT TREMAINE LLP  
 2600 CENTURY SQUARE  
 1501 FOURTH AVENUE  
 SEATTLE, WA 98101-1688

EXAMINER

YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

94.

## Office Action Summary

### Application No.

09/994,365

### Applicant(s)

CHARMLEY ET AL.

### Examiner

MISOOK YU, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-57 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 16, 19 partially, 26 partially, 27 partially, 52 partially, drawn to cDNA encoding SEQ ID NO:2 and 3 and method of producing CAN-1 protein, oligonucleotide from cDNA, classified in class 536, subclass 23.1, and others
- II. Claims 13-15, 17 18, 19 partially, 26 partially, 27 partially, 52 partially drawn to genomic DNA, oligonucleotide from genomic DNA, classified in class 536, subclass 23.1, and others.

Claims 20, and 25 link(s) inventions III and IV. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 20, and 25. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no

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longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

- III. Claims 21, 23, 26 partially, 27 partially, 52 partially, drawn to cDNA encoding SEQ ID NO:5, classified in class 536, subclass 23.1, and others.
- IV. Claims 22, 24, 26 partially, 27 partially, 52 partially, drawn to genomic DNA encoding SEQ ID NO:5, classified in class 536, subclass 23.1, and others.
- V. Claims 28-30, drawn to CAN-1 polypeptide, classified in class 530, subclass 350.
- VI. Claim 31, drawn to SEQ ID NO:9, classified in class 530, subclass 350.
- VII. Claim 32, drawn to SEQ ID NO:6, classified in class 530, subclass 350.
- VIII. Claims 33 partially, 34-41, drawn to antibody to SEQ ID NO:2 and 3, classified in class 530, subclass 387.1.
- IX. Claims 33 partially, 42-45, drawn to antibody to SEQ ID NO:6, classified in class 530, subclass 387.1.
- X. Claims 33 partially, 46-49, drawn to antibody to SEQ ID NO:9, classified in class 530, subclass 387.1.
- XI. Claim 50 partially, drawn to method of diagnosing psoriasis by determining expression level of CAN-1 protein, classified in class 435, subclass 7.1.
- XII. Claim 50 partially, drawn to method of diagnosing psoriasis by determining expression level of STG protein, classified in class 435, subclass 7.1.

- XIII. Claim 50 partially, drawn to method of diagnosing psoriasis by determining level of SEEK-1 protein, classified in class 435, subclass 7.1.
- XIV. Claim 51 partially, drawn to method of ameliorating the symptoms of psoriasis by administering an inhibitor of CAN-1 protein, unclassifiable due to the unknown nature of the inhibitor.
- XV. Claim 51 partially, drawn to method of ameliorating the symptoms of psoriasis by administering an inhibitor of STG protein, unclassifiable due to the unknown nature of the inhibitor.
- XVI. Claim 51 partially, drawn to method of ameliorating the symptoms by administering an inhibitor of SEEK-1 protein, unclassifiable due to the unknown nature of the inhibitor.
- XVII. Claim 53 partially, drawn to method of finding a binding partner of CAN-1 protein, classified in class 435, subclass 4.
- XVIII. Claim 53 partially, drawn to method of finding a binding partner of STG protein, classified in class 435, subclass 4.
- XIX. Claim 53 partially, drawn to method of finding a binding partner of SEEK-1 protein, classified in class 435, subclass 4.
- XX. Claims 54, and 55, drawn to method of inhibiting movement of cells using a binding partner of a CAN-1, unclassifiable due to the unknown nature of the binding partner.

XXI. Claim 56, drawn to method of inhibiting hyperproliferation of keratinocytes using a binding partner of a CAN-1, unclassifiable due to the unknown nature of the binding partner.

XXII. Claim 57, drawn to method of inhibiting abnormal differentiation of keratinocytes using a binding partner of a CAN-1, unclassifiable due to the unknown nature of the binding partner.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different products, one is cDNA encoding a protein and the other is genomic DNA with introns and other regulatory sequences that have different modes of operation, different functions, or different effects.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different products, one is cDNA encoding a protein and the other is genomic DNA with introns and other regulatory sequences that have different modes of operation, different functions, or different effects.

Inventions V-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

the instant case the different inventions V-VII are different proteins with different biological activities, and inventions VIII-X are different antibodies capable of binding different proteins with different biological activities.

The product invention group V, and the method invention groups XI, and XVII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of group XI or group XVII.

The product invention group VI, and the method invention groups XIII, and XIX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of group XIII or group XIX.

The product invention group VII, and the method invention groups XII, and XVIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case the product as claimed can be used in a materially different process of group XII or group XVIII.

Inventions XIV-XVI, and XX-XXII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects and different modes of operation because each of the unspecified compound or binding partner binds or inhibits different proteins with different biological proteins.

These inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification. The search required for each of the above inventions is not coextensive with regard to the literature and the sequence searches. Further, a reference which would anticipate the invention of any one group would not necessarily anticipate or make obvious the any of the other groups. For these reasons, restriction for examination purposes is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MISOOK YU, Ph.D.  
Examiner  
Art Unit 1642